

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Mark C. Carroll et al.

Application No.: 10/628,579

Confirmation No.: 4098

Filed: July 29, 2003

Art Unit: 1742

For: 5000 SERIES ALLOYS WITH IMPROVED  
CORROSION PROPERTIES AND METHODS  
FOR THEIR MANUFACTURE AND USE

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Examiner: J. C. Morillo

**AMENDMENT IN RESPONSE TO NON-FINAL ACTION (37 C.F.R. § 1.111)**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a timely response to the Office Action dated July 12, 2006, rejecting claims 4, 5, 7, 9, 10, 16, 22, 24, 25, 38, 39, 42 and 43.

**Remarks/Arguments** begin on page 2 of this paper.

**REMARKS**

Receipt of the Office Action mailed July 12, 2006 is acknowledged. Applicants gratefully acknowledge the indication that the RCE request has been accepted, that the claim amendments have been entered, and that the claim rejection under 35 U.S.C. 102 over Haszler has been overcome.

The Office Action, however, continues to reject the claims as anticipated by the Carroll et al. article ("Carroll"), and obvious over, or over Haszler. Applicants respectfully traverse.

**Regarding Carroll and the adequacy of the § 1.132 Declaration**

The current application lists seven (7) inventors. The Carroll article, published less than a year prior to the filing date of the application, lists five (5) co-authors, four of which are among the named co-inventors (four "*author-inventors*"). A declaration, signed by all co-inventors, explains that the fifth co-author (the "*non-inventor author*"), did not make any inventive contribution to the publication. This declaration is accepted by the PTO.

The Office Action continues to assert that there is a need for applicants to establish that the non-author inventors had not contributed to the claimed invention. This is wrong.

In effect, the Office Action asks the applicants to state that the *non-author inventors* had not contributed to the instantly claimed invention, while it is not the case. The non-author inventors definitely had made contribution to the instantly claimed invention, or they would not have been named as co-inventors. In fact, all co-inventors have signed the original declaration attesting to the fact that they made contribution to the invention as claimed. If applicants made statements that the non-author inventors did not make contributions to the invention, it would make the current inventorship improper and any resultant patent invalid.

As indicated in the previous response, the non-author inventors have made contributions to other claims under examination, but not under direct rejection under §1-2(a) over the Carroll article. What is most important, however, is that the law does not require an inquiry as to what precisely each inventor contributed to the invention. In their previous response, applicants have explained this by discussing *In re Carreira*, 532 F.2d 1356 (CCPA 1976). To further illustrate this point, the Office is directed to *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Inter. 1982), discussed in MPEP § 2132.01. There, the article cited under 35 U.S.C. § 102(a) lists Kroger, Knaster and others as co-authors, and the patent application lists Kroger and Rod as co-inventors. Rod is the “non-author inventor.” The Board made it clear that there is no need for it to be established that Rod had not contributed to the claimed invention.

In this instant case, existing evidence shows that the non-author inventors did not make any contribution to *the published article*, or they would have been named as co-authors. To put it another way, it is clear that the *author inventors* made the claimed invention, and described the same invention in the article. The Office Action now is using the article, that describes the inventors’ own work, to reject the their own invention. Under the law, this is incorrect, because the Carroll article is not prior art because it was not by “another,” and cannot be used to reject the claims to their own invention.

In any event, there is absolutely no evidence that the references cited for rejecting the claims are NOT the inventors’ own work.

Accordingly, applicants respectfully submit that it is improper for the Office Action to continue to rejection the claims under Carroll, and request that such rejections be withdrawn.

**Regarding proximity in range as *prima facie* obviousness**

The Office Action continues to reject the claims as obvious over Haszler. Under the logic of the Office Action, not only a reference that discloses a composition whose range is “in

close proximity” (whatever that may mean) to the claimed range, alone, is sufficient to establish a *prima facie* case of obviousness, such a *prima facie* obviousness can never be successfully rebutted because any property of the new, claimed composition would be “inherent” in the old composition. Such a logic is legally wrong.

The claimed alloy of the present invention has 4-4.9% of Mg, while Haszler’s has 5-6%. Also, the claimed alloy has, inter alia, novel and improved characteristics including quaternary tau phase and is SCC resistant.

The Office Action first asserts that the ranges are so close that it is *prima facie* obvious. This is itself not true. In any case, even assume there was a *prima facie* case of obviousness, applicants have overcome it by showing that the two above properties were unexpected and superior.

The Office Action, however, further asserts that the Haszler alloy “inherently” has the same properties. This is circular logic. The Office Action is in effect asserting that the differences in compositions are not important in any way (i.e. “obvious”), but when the applicants provide evidence that the differences are important and result in improved properties, the Office Action turns around and assert that the old composition, although different, would have the same properties any way. Under this logic, applicants would never be able to rebut the *prima facie* case of obviousness, as the Office needs to provide no evidence one way or the other regarding whether there would not be any differences in properties.

Inherency in properties exists only when the compositions are identical. The law has never been extended to the absurd extent that “compositions in close proximity” would always and inherently have the exact same properties. If this logic is carried to its extreme, then there would never be anything that is not obvious over any other thing, because the differences between any two things in the world can always be divided into a series of very small differences, which then can be ignored due to “inherency.”

Further, the reliance by the Office Action on the *Titanium Metal* case is misplaced, because there was no rebuttal whatsoever in that case of the *prima facie* case. Here, the applicants have successfully rebutted the so-called *prima facie* case with concrete evidence.

In conclusion, applicants respectfully submit that the two bases on which the Office Action maintains the claim rejections are improper. Accordingly, all claims under consideration are allowable. Applicants respectfully and earnestly solicit an early indication from the Examiner that the claims are allowable.

Should the Examiner disagree with the applicants, it is respectfully requested that the Examiner call the undersigned, or grant an opportunity for the undersigned to conduct an office interview, to further discuss the issues.

Applicant believes no fee is due at this time. Should any fees be deemed necessary, the Commissioner is hereby authorized to please charge them to our Deposit Account No. 11-0553.

Dated: October 12, 2006

Respectfully submitted,

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